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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,219	10/20/2000	Paul Lapstun	NPA031US	7823

24011 7590 06/29/2005

SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER
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PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<p>Application No.</p> <p align="center">09/693,219</p>	<p>Applicant(s)</p> <p align="center">LAPSTUN ET AL.</p>	
	<p>Examiner</p> <p align="center">Thierry L. Pham</p>	<p>Art Unit</p> <p align="center">2624</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,6-13 and 15-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-13 and 15-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/11/05</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 4/11/05.
- Claims 1-2, 6-13, 15-30 are pending; claims 3-5, and 14 have been canceled.
- Amendment After Final filed on 2/6/05 has been entered.
- Amendment filed with respect to the specification on 2/6/05 has been entered.
- IDS filed on 4/11/05 has been received and considered by the examiner.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 18-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide an adequate written description of the limitations as recited in claims 1-2, 18-19, wherein “markings associated with digital ink”; therefore, it does not enable one skilled in the art to make, use and/or practice the invention. According to the response filed on 2/6/05, the applicants acknowledged “digital ink” is widely known and available in the art and provided a teaching reference (US 20020081027) that states a “digital ink” refers to a digital representation of a non-textual image or manually generated image, such as a signature, a handwritten note or a graphic image. The definitions provided by the applicants are not sufficient, since it was published *after* the applicant’s original disclosure; therefore, it was not known in the art *prior* to applicant’s invention. In addition, the examiner is unclear whether digital ink is visible and/or invisible to the users/operators. According to the original filed specification, pages 22-23, digital ink markings are markings that generated by the netpage pen (ref. 101, fig. 2), and herein, the examiner interprets digital inks as markings generated by stylus (pointer 502, fig. 1 of Dymetman) pen as equivalent to netpage pen as shown in fig. 2.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 & 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For example, claim 1 cites “printing a copy of the document and, at the same time, printing on the copy coded data indicative of an identity of the copy”. The examiner is unclear whether the coded data is different than the coded data already encrypted in the original document to be scanned. Herein, the examiner interprets the coded data is the same as the coded data that encrypted in the original document. In addition, the examiner recommends the applicant to change “printing a copy of the document and, at the same time, printing on the copy coded data indicative of an identity of the copy” to “printing a copy of the document and, at the same time, printing on the *printed* copy a coded data indicative of an identity of the copy”.

Claims 1 & 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For example, claim 1 cites “wherein the printed copy of the document duplicates the markings associated with digital ink but does not duplicate the markings not associated with digital ink”. The examiner unclear whether an additional printed copy is required that determines whether or not duplication is necessary. The examiner suggests of rephrasing the limitations to “wherein markings associated with digital ink are duplicated on the printed copy of the document and markings not associated with digital ink are not duplicated on the printed copy of the document” and/or equivalent. Please refer to page 23, lines 1-19 of the original filed specification for more details.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 6-13, 15-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata et al (US 6537324), and in view of Dymetman et al (US 6330976).

Regarding claim 18, Tabata discloses a system enabling the copying of documents, including:

- a scanner (scanner 60, fig. 1, col. 5, lines 40-58) for scanning a document (medium form which contains both coded data and document data, fig. 2, col. 5, lines 40-58) that contain coded data indicative (barcode data incorporated a linkage information for identifying correlated information file from the file server, fig. 2, col. 5, lines 50-67 to col. 6, lines 1-67 and col. 8, lines 62-67) of an identity of the document and enabling formation of a digital image of the document;
- a detector (a detector incorporated in the scanner for detecting coded data as shown in fig. 2, col. 6, lines 6, lines 60-67 to col. 7, lines 1-10) for detecting the coded data;
- a data store including data (file server 20 for storing correlated information files, fig. 1, col. 5, lines 20-58 and col. 6, lines 10-25) representing document content; and
- a printer (printer 40 and 80, fig. 1, col. 5, lines 20-57 and col. 6, lines 47-57) adapted for printing a copy of the document and, at the same time, printing on the copy coded data indicative of an identity of the copy (i.e. medium form 201, fig. 2), wherein the printed copy of the document (printed copy 201 also includes a coded data contains linkage information for identifying the document stored in the server, fig. 2).

However, Tabata fails to teach and/or suggest a document includes markings associated with digital ink, markings not associated with digital ink, and wherein a printer only duplicates

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the markings associated with digital ink but does not duplicates the markings not associated with digital ink.

Dymetman, in the same field of endeavor for scanning coded data, teaches a document includes markings associated with digital ink (pointer 502 includes pen-like instrument for writing digital ink onto a coded substrate and/or any ordinary writing surface, figs. 1 & 9, col. 22, lines 10-65), markings not associated with digital ink, and wherein a printer (facsimile apparatus as taught by Dymetman for faxing only messages written with digital ink, col. 22, lines 10-65) only duplicates the markings associated with digital ink but does not duplicates the markings not associated with digital ink.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying the system of Tabata to include a printer and/or facsimile apparatus as taught by Dymetman for reading document that includes markings with digital inks and markings without digital inks and duplicates markings with digital ink because of a following reason: (●) using pen-like pointer 502 (fig. 1) for writing digital inks coded data and/or any ordinary writing surface and only transmits (i.e. faxing) markings with digital ink (i.e. messages written with pen-like pointer) rather than all the contains within a document; therefore, reducing transmission time.

Therefore, it would have been obvious to combine Tabata with Dymetman to obtain the invention as specified in claim 18.

Regarding claim 19, Tabata discloses a system enabling the copying of documents, including:

- a scanner (scanner 60, fig. 1, col. 40-58) for scanning a document that contains coded data indicative of an identity (medium form which contains both coded data and document data, fig. 2, col. 40-58) of the document and enabling formation of a digital image of the document;
- a detector (a detector incorporated in the scanner for detecting coded data as shown in fig. 2, col. 6, lines 6, lines 60-67 to col. 7, lines 1-10) for detecting the coded data;
- a first data store including data (file server 20 for storing correlated information files, fig. 1, col. 5, lines 20-58 and col. 6, lines 10-25) representing document content, accessible if the document contains said coded data indicative of the identity of the document (barcode data

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incorporates a linkage information that links information (HTML/URL address, fig. 7), cols. 5-7 and col. 10, lines 8-20); and

- a second data store including (file server 20 for storing correlated information files, fig. 1, col. 5, lines 20-58 and col. 6, lines 10-25) data representing a copy of the document, together with a unique identifier (barcode data incorporates a linkage information that links information (HTML/URL address for correlated files, cols. 5-7 and col. 10, lines 8-20) for the copy, wherein data in second data store representing a copy of the document.

However, Tabata fails to teach and/or suggest a document includes markings associated with digital ink, markings not associated with digital ink, and wherein a second storage stores only the markings associated with digital ink but does not stores the markings not associated with digital ink.

Dymetman, in the same field of endeavor for scanning coded data, teaches a document includes markings associated with digital ink (pointer 502 includes pen-like instrument for writing digital ink onto a coded substrate and/or any ordinary writing surface, figs. 1 & 9, col. 22, lines 10-65), markings not associated with digital ink, and wherein a storage (pointer 502 writes messages and stores only messages written with digital ink, col. 22, lines 10-65) only stores the markings associated with digital ink but does not stores the markings not associated with digital ink.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying the system of Tabata to include a printer and/or facsimile apparatus as taught by Dymetman for reading document that includes markings with digital inks and markings without digital inks and duplicates markings with digital ink because of a following reason: (●) using pen-like pointer 502 (fig. 1) for writing digital inks coded data and/or any ordinary writing surface and only stores (i.e. faxing) markings with digital ink (i.e. messages written with pen-like pointer) rather than all the contains within a document; therefore, reducing storage memory costs.

Therefore, it would have been obvious to combine Tabata with Dymetman to obtain the invention as specified in claim 19.

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Regarding claim 20, Tabata further discloses a system according to claim 19, including a server (file server, fig. 1, col. 5, lines 20-58) for allocating a unique identifier to each said copy.

Regarding claim 21, Tabata further discloses a system according to claim 19 connectable with a printer (printer 40 and 80, fig. 1, col. 5, lines 20-57 and col. 6, lines 47-57) adapted for printing a copy of the document and, at the same time, printing the copy coded data indicative of an identity of the copy (i.e. medium form, fig. 2).

Regarding claim 22, Dymetman further teaches a sensing device operable by a user to identify said coded data printed on said copy (sensing device 502 for detecting/sensing coded data, figs. 1, 14-15, cols. 3-4 and col. 8, lines 45-67).

Regarding claim 23, Dymetman further teaches the sensing device including a marking nib (marking tip 505, fig. 11).

Regarding claim 24, Dymetman further teaches the sensing device including an identification means (network address of the sensing device, col. 9, lines 16-45), which imparts a unique identity to the sensing device, the system able to associate the identifier for the copy with the identity of the sensing device.

Regarding claims 25-26, the printer including a binder for binding pages of a multi-page copy and wherein scanner and the printer being provided as parts of a single apparatus (multifunctional copy machine including scanning, faxing, printing, and stapling functions are known in the art).

Regarding claim 27, Tabata further discloses a system according to claim 18, the scanner and the detector being provided as parts of a single apparatus (a detector incorporated in the scanner for detecting coded data as shown in fig. 2, col. 6, lines 6, lines 60-67 to col. 7, lines 1-10).



Regarding claim 28, Tabata further discloses a system according to claim 27, the scanner comprising a moving linear image sensor device (all scanners include a CCD for reading images, fig. 2, col. 6, lines 6, lines 60-67 to col. 7, lines 1-10), the detector carried by this device.

Regarding claim 29, Dymetman further teaches the sensing device adapted to communicate with a base station (fig. 2 as per teaching of Dymetman), the scanner and base station (scanner, fig. 1, as per teachings of Tabata) provided as parts of a single apparatus.

Regarding claim 30, Tabata further discloses a system according to claim 18 including authorization means to prevent use by an unauthorized user (user ID and passwords, col. 15, lines 20-60).

Regarding claims 1-2, 6-13, 15-17: Claims 1-2, 6-13, 15-17 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 18-30; therefore, claims 1-2, 6-13, 15-17 are rejected for the same rejection rationale/basis as described in claims 18-30 above.

For example, regarding claim 1, Tabata discloses a method enabling the copying (digital copy machine, col. 6, lines 58-65) of documents, the method including the steps of:

- scanning (scanner 60, fig. 1, col. 5, lines 40-58 and col. 6, lines 58-67 to col. 7, lines 1-10) a document which that contains coded data indicative of an identity of the document (medium form which contains both coded data and document data, fig. 2 and figs. 4-7, col. 5, lines 40-58 and col. 8, lines 15-67), and forming a digital image (digital image is stored via a file server, col. 5, lines 20-58 and col. 6, lines 10-25) of the document;
- detecting (a detector incorporated in the scanner for detecting coded data as shown in fig. 2, col. 6, lines 6, lines 60-67 to col. 7, lines 1-10) the coded data;
- identifying differences between the digital image and stored data (scanner for identifying differences between coded data that stores URL link information and stored data such as printed data on ordinary print medium, fig. 1, col. 5, lines 40-58 and col. 6, lines 58-67);

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- accessing stored (accessing file server for digital copy of the document using linkage information (i.e. URL address) from the coded data, figs. 2-12, col. 8, lines 15-62 and col. 10, lines 8-20) data representing the content of the document; and
- printing (printer 40 and 80, fig. 1, col. 5, lines 20-57 and col. 6, lines 47-57) a copy of the document and, at the same time, printing on the copy coded data (i.e. medium form which contains both document data and coded data, fig. 2, col. 8, lines 15-50) indicative of an identity of the copy;

However, Tabata fails to teach and/or suggest a document includes markings associated with digital ink, markings not associated with digital ink, and wherein a printer only duplicates the markings associated with digital ink but does not duplicates the markings not associated with digital ink.

Dymetman, in the same field of endeavor for scanning coded data, teaches a document includes markings associated with digital ink (pointer 502 includes pen-like instrument for writing digital ink onto a coded substrate and/or any ordinary writing surface, figs. 1 & 9, col. 22, lines 10-65), markings not associated with digital ink, and wherein a printer (facsimile apparatus as taught by Dymetman for faxing only messages written with digital ink, col. 22, lines 10-65) only duplicates the markings associated with digital ink but does not duplicates the markings not associated with digital ink.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying the system of Tabata to include a printer and/or facsimile apparatus as taught by Dymetman for reading document that includes markings with digital inks and markings without digital inks and duplicates markings with digital ink because of a following reason: (•) using pen-like pointer 502 (fig. 1) for writing digital inks coded data and/or any ordinary writing surface and only transmits (i.e. faxing) markings with digital ink (i.e. messages written with pen-like pointer) rather than all the contains within a document; therefore, reducing transmission time.

Therefore, it would have been obvious to combine Tabata with Dymetman to obtain the invention as specified in claim 1.

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***Response to Arguments***

Applicant's arguments, see pages 8-9, filed 2/6/05, with respect to the rejection(s) of claim(s) 18-21, 27-28, and 30 under 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art reference due to newly added limitations "i.e. markings associated with digital inks and markings not associated with digital ink".

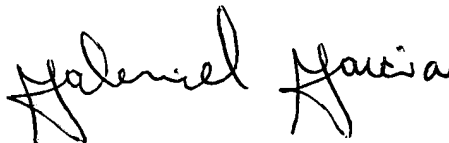
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA  
PRIMARY EXAMINER